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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hiram M. Samel

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,229

Applicant(s)

SAMEL, HIRAM M.

Examiner

Jenna-Leigh Befumo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on June 23, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The term “tightly woven” is defined based on paragraph 27 in the specification which states that a “tightly woven fabric leaves gaps sufficiently small that a liquid backing may be applied, such as applying a latex backing.” Since the first definition which defines “tightly” with respect to the gap size and whether or not a liquid backing can be applied to the fabric layer does not define the viscosity of the liquid or even state whether or not the backing is produced without the liquid coating soaking into the fabric to any degree. Further, the applicant doesn’t state that the backing has to be continuous or if a discontinuous backing would be allowed. Therefore, the term is interpreted as meaning that the yarns are close together so that there are no relatively large gaps in the fabric and that a coating material such as a latex, would produce a backing layer when applied to the fabric.

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3. The term “wide loom” is not clearly defined by the applicant. And while the term is used to described looms which make wide fabrics as opposed to narrow fabrics, the Examiner could not find any definition of how wide a loom must be to be a “wide loom”. However, according to the *Wellington Sears Handbook of Industrial Textiles*, narrow fabrics are defined as fabrics which are 12 inches or less (see page 136). Therefore, a wide loom is considered to be any loom which would produce a fabric having a width greater than 12 inches.

4. The term “immediately” in claim 7 is interpreted as meaning weaving is the next step after twisting.

Drawings

5. The drawings are objected to because the reference numbers and figures numbers are uneven and hard to read in places.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference characters not mentioned in the description: 32 and 34 (in Figures 3A and 3B).

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference signs mentioned in the description: Figure 4, mentioned on page 10 of the disclosure and references numbers 41 – 47 are not in the drawings.

8. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion

of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 50 of U.S. Patent No. 6,506,697 for the reasons set forth in the previous Office Action.

Claim Rejections - 35 USC § 102

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Bray (280,286).

The features of Bray have been set forth in the previous Office Action. Bray discloses a woven paper fabric produced by weaving together twisted paper yarns (lines 20 – 30). Bray discloses that when the strands are “closely woven” they can be subjected to a moderate amount of washing (lines 45 – 50). The term “closely woven” reads on the term “tightly woven”

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as defined by the applicant since Bray discloses that his invention is not intended to be a “coarse open-meshed fabric” (lines 78 – 83). Thus, Bray’s invention is drawn to a woven fabric with small gaps between the yarns.

13. Claims 1 – 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Crawford (2,787,045).

Crawford discloses a woven paper material comprising paper warp yarns and paper filling yarns formed of twisted paper strips (column 1, lines 46 – 50). The fabric can have about 16 warp ends per inch and about 11 filling ends per inch although these may range from 10 to 30 as desired (column 3, lines 26 – 31). Therefore, Crawford reads on the term “tightly woven” since Crawford teaches using the claimed yarn density. Claims 1 – 3 are anticipated.

14. Claims 1 – 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Howell (3,282,038).

Howell discloses twisted paper yarns that find use in various applications (column 1, lines 12 – 20). The yarns can be woven or knitted into fabrics (column 1, lines 47 – 50). Further, The example discloses a woven fabric having 28 ends per inch in the warp direction and 22 ends per inch in the fill direction (column 4, lines 40 – 45). Thus, Howell, reads on the term “tightly woven” since Howell teaches using the claimed yarn density. Claims 1 – 3 are anticipated.

15. Claims 1 – 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Snyder (3,561,998).

Snyder discloses a woven paper fabric produced with 15 ends per inch in the warp direction and 12 picks per inch in the fill direction (column 4, lines 14 – 16). Further, this woven

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product is shown in Figure 3 which shows that paper yarns are closely woven together without any spaces between the yarns. Therefore, the fabric is "tightly woven" as shown in the figures and since Snyder teaches using the claimed yarn densities. Thus, claims 1 – 3 are anticipated.

Claim Rejections - 35 USC § 103

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

17. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bray.

The features of Bray have been set forth above. Bray discloses that the fabric is woven by any well-known weaving method (lines 25 – 30). Also Bray discloses that the fabric is used as floor coverings and the fabric be woven into any determined dimensions so that the floor covering is a single piece. Therefore, it would have been obvious to one of ordinary skill in the art to produce the fabric on a wide loom to make floor coverings which are a single piece and cover the floor in rooms having widths greater than 12 inches.

18. Claims 4, 5, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford.

The features of Crawford have been set forth above. Crawford discloses that the woven fabric is produced by twisting the warp and filling yarns and applying a water wax emulsion to the yarns, before, during, or after twisting (column 2, lines 55 – 60). Applying the water wax emulsion before or during twisting would read on the limitation that the yarns are produced by twisting wetted paper. The fabric is then produced by weaving together the paper strips (column 1, lines 55 – 57). The fabric is finally calendered and passed through a impregnation bath which coats both sides of the fabric with a coating, which would correspond to the applicant's backing

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(column 3, lines 10 – 15). While Crawford fails to teach weaving the fabric on a wide loom, Crawford discloses that the fabric can be used to flooring or trunk linings. Therefore, it would have been obvious to one of ordinary skill in the art to produce the fabric on a wide loom so that less fabric pieces need to be sewn or bonded together to form a wide fabric. Further, it is less expensive and more efficient to form a wide fabric than producing multiple narrow fabrics and sewing them together to form a larger fabric since the step of sewing the pieces together is skipped. Therefore, claims 4, 5, 6, and 9 are rejected.

19. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell.

The features of Howell have been set forth above. Howell discloses in the examples that after the paper yarns are twisted they woven into fabrics on conventional equipment. Howell fails to teach using a wide loom to produce the woven fabric. It would have been obvious to one of ordinary skill in the art to produce the woven fabric on a wide loom so that larger pieces of fabric can be produced quicker and more efficiently. Therefore, claims 4 and 5 are rejected.

20. Claims 4, 5, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder.

The features of Snyder have been set forth above. Snyder teaches that the fabric is produced in a continuous production process (column 3, lines 10 – 12). Snyder fails to teach what type of machine is used to weave the fabric. However, Snyder teaches that the fabric can be used as wall coverings or panel overlays (column 1, lines 35 – 40), and that the fabric can be applied to large articles such as wood, plywood, gypsum board, or hardboard (column 3, lines 60). Therefore, it would have been obvious to one of ordinary skill in the art to produce the fabric on a wide loom to produce larger fabrics so that fewer pieces are need to cover the support

articles. Further, it is more efficient to make one larger piece of fabric which can be cut into multiple small pieces instead of making multiple small pieces, because it requires less time and energy to make one 10 foot wide fabric and cutting the fabric into smaller sections, instead of making 10 – one foot wide pieces of fabric. Therefore, claims 4 and 5 are rejected. Also Snyder teaches that the fabric can be cut into smaller section based on the desired size of the final product (column 3, lines 54 – 56). Therefore, claim 10 is rejected. Finally, Snyder teaches that the fabric can be bonded to support layers or the fabric can be coated with a polymer composition (column 2, lines 20 – 25). Therefore, claim 9 is rejected.

21. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bray, Crawford, Howell, or Snyder in view of *Wellington Sears Handbook of Industrial Textiles* (page 111).

The features of Bray, Crawford, Howell, and Snyder have been set forth above. Each reference teaches that the fabric is produced by weaving, but fails to teach that the yarns are provided to the loom at a controlled tension. *Wellington Sears Handbook of Industrial Textiles* teaches that the warp yarns are supplied to the loom at a controlled tension to control the crimp of the yarns and other fabric properties (page 111). In fact, the warp yarns must be under some degree tension to run in the machine and produce the woven fabric. Therefore, it would have been obvious to one of ordinary skill in the art to provide the yarns to the loom under tension to control the crimp in the yarn and other fabric properties and produce the woven fabric. Thus, claim 8 is rejected.

22. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bray in view of Evans (3,357,172).

The features of Bray are set forth above. While Bray discloses that the woven paper fabric is produced by known methods, Bray fails to teach that the paper slits are wet when they are twisted. Evans is drawn to twisted paper yarn. Evans discloses that paper yarns are commonly produced by a process wherein slits of paper are dipped or soaked in water prior to twisting or folding the paper strips into a yarn (column 1, lines 46 – 50). Therefore, it would have been obvious to one of ordinary skill in the art to wet the paper slits prior to slitting in the product taught by Bray since Evans teaches that paper yarns are commonly produced by wetting the paper strips and Bray teaches that the woven paper fabrics are produced by known methods. Thus, claim 6 is rejected. Further, claim 7 is rejected since Bray teaches that the woven fabric can be produced without treating the paper yarns with a waterproof coating, and hence, weaving would be immediately after twisting. Further, Bray teaches that the paper yarns can be treated after the yarns are woven into a fabric, and thus, the weaving step is immediately after the twisting step (lines 30 – 33).

23. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell in view of Evans.

The features of Howell are set forth above. Howell fails to teach that the paper slits are wet when they are twisted. Evans is drawn to twisted paper yarn. Evans discloses that paper yarns are commonly produced by a process wherein slits of paper are dipped or soaked in water prior to twisting or folding the paper strips into a yarn (column 1, lines 46 – 50). Therefore, it would have been obvious to one of ordinary skill in the art to wet the paper slits prior to slitting in the product taught by Howell since Evans teaches that paper yarns are commonly produced by wetting the paper strips. Thus, claim 6 is rejected. Further, claim 7 is rejected since Howell

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teaches that the twisted yarns are produced and then woven into a fabric on conventional equipment (column 4, lines 38 – 40).

24. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder in view of Evans.

The features of Snyder are set forth above. While Snyder discloses that the woven paper fabric is produced by known methods, Snyder fails to teach that the paper slits are wet when they are twisted. Evans is drawn to twisted paper yarn. Evans discloses that paper yarns are commonly produced by a process wherein slits of paper are dipped or soaked in water prior to twisting or folding the paper strips into a yarn (column 1, lines 46 – 50). Therefore, it would have been obvious to one of ordinary skill in the art to wet the paper slits prior to slitting in the product taught by Snyder since Evans teaches that paper yarns are commonly produced by wetting the paper strips and Snyder teaches that the woven paper fabrics are produced by known methods. Thus, claim 6 is rejected. Further, claim 7 is rejected since teaches that the woven fabric is formed in a continuous process and the woven fabric is produced from the twisted paper yarns and then the fabric is treated, the yarns aren't treated individually (column 2, lines 15 – 25).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jenna-Leigh Befumo
August 26, 2004



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